

## **REMARKS**

This paper is being submitted in response to the non-final office action dated October 12, 2007. Claims 1-18 and 20 were pending. By this amendment, claim 18 is amended. Support for the amendment to claim 18 may be found in the specification and claims as originally filed. No new matter is added. As a result, claims 1-18 and 20 remain pending and at issue.

### **Rejections Under 35 U.S.C. § 102 (b) Over Beck and Foster**

The applicants respectfully traverse the rejection of claim 18 as allegedly anticipated by U.S. Patent No. 3,724,920 to Beck (“Beck”) or U.S. Patent No. 5,815,903 to Foster et al. (“Foster”). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987).

Claim 18 recites a container for holding hanging file folders comprising, *inter alia*, surfaces for supporting hanging file folders, wherein the surfaces are configured to support the hanging file folders in a cascading stair-step fashion and at least one step is disposed between two adjacent steps, each step having a different elevation. Neither Beck nor Foster disclose a step that is disposed between two adjacent steps, each step having a different elevation.

Rather, both Beck and Foster disclose support surfaces (16, 14) that are substantially straight, only bending upward at respective ends to facilitate attaching the surfaces (16, 14) to container walls (14) or support trays (20). The end portions of the support surfaces (16, 14) have the same elevation. Thus, neither Beck nor Foster discloses or suggests a support surface having at least one step disposed between two adjacent steps and each step having a different elevation, as is recited by claim 18. As a result, claim 18 cannot be anticipated by either of Beck or Foster. The applicants respectfully request withdrawal of the rejection of claim 18.

### **Rejections Under 35 U.S.C. § 103(a)**

The applicants respectfully traverse the rejection of claims 1-17 and 20 as allegedly obvious over one or more of U.S. Patent No. 6,672,439 to Platte III (“Platte”); U.S. Patent No. 5,779,331 to Fox et al. (“Fox”); U.S. Patent No. 3,281,193 to Murray (“Murray”); U.S. Patent No. 6,126,012 to Roegner (“Roegner”); U.S. Patent No. 6,206,567 to Cyr (“Cyr”); and U.S. Patent No. 5,873,730 to Strong (“Strong”). “All words in a claim must be considered in judging the patentability of the claim against the prior art.” M.P.E.P. § 2143.

#### Claims 1-17

Each of claims 1-17 recites a rigid structural portion and a cover portion removably attached to the rigid structural portion. The Office Action has failed to cite any reference disclosing a container having a removable cover portion. For this reason alone, the rejection of claims 1-17 is improper and should be withdrawn.

It is alleged in the Office action that “it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art.” *See* the office action, page 4, citing *Nerwin v. Erlichman*, 168 USPQ 177, 179. However, the applicants respectfully submit that this is a mischaracterization of the holding of *Nerwin*. *Nerwin* stands for the proposition that the “mere fact that a given structure is integral does not preclude its consisting of various elements.” *Id.*, at 179. In *Nerwin*, the issue was whether an integral structure could consist of various parts. *Id.*, at page 178. *Nerwin* contended that certain limitations were set forth in two different elements, that Erlichman’s disclosure of these limitations could only find support in a single structure, and that Erlichman should not be allowed to use the single structure to meet two positively stated and claimed elements. *Id.*, at pages 178-179.

Even if one were to read the holding of *Nerwin* to stand for the proposition alleged by the examiner, that proposition is irrelevant to the issue at hand. The issue here is

not whether an integral structure could be made in various elements, the issue here is whether it is obvious to make a non-removable cover removable. The applicants respectfully submit that *Nerwin* does not address the issue of making non-removable parts removable. Thus, the examiner bears the burden of establishing a *prima facie* case that making a non removable cover removable would be obvious to one skilled in the art. Part of the *prima facie* case is citing prior art that discloses a removable cover. The Office action has cited no prior art disclosing a removable cover. To the contrary, the examiner appears to concede that none of the cited art discloses a removable cover. For example, “Platte discloses that the cover may be sewn or otherwise attached to the top edge of the back wall,” “Cyr discloses a portable container comprising . . . a cover portion . . . attached to the rigid structural portion,” and “Strong discloses . . . a cover portion (closure flap 32) attached to the rigid structural portion.” See the official action pages 4, 6, and 7. In each case, the examiner cites *Nerwin* to cure the deficiency that none of the cited art discloses a removable cover. However, *Nerwin* does not stand for the proposition that it is obvious to make a non-removable cover removable. Thus, the examiner has failed to establish a *prima facie* case of obviousness.

Because the Office action has failed to establish a *prima facie* case of obviousness, none of claims 1-17 can be rendered obvious by any combination of the cited art. The applicants respectfully request withdrawal of the rejection of claims 1-17.

#### Claim 20

The applicants respectfully traverse the rejection of claim 20 as obvious over Beck or Foster in view of Murray. Claim 20 now recites a container for holding hanging file folders comprising, *inter alia*, a step that is disposed between two adjacent steps, each step having a different elevation. As shown above with respect to the § 102 rejections, Both Beck and Foster fail to disclose or suggest a step that is disposed between two adjacent steps, each step having a different elevation.

Likewise, Murray fails to disclose or suggest a step that is disposed between two adjacent steps, each step having a different elevation, nor was Murray cited as disclosing such an element. While Murray discloses a filing cabinet for holding file folders, the cabinet does not have steps of any sort. *See, e.g., Murray, Fig. 1.* In fact, the Murray device supports file folders along tracks 17, 18, and these tracks do not have steps of any sort. Thus, Murray fails to disclose or suggest a step that is disposed between two adjacent steps, each step having a different elevation as is recited by claim 20.

Because Beck, Foster and Murray fail to disclose or suggest a step that is disposed between two adjacent steps, each step having a different elevation, claim 20 cannot be anticipated by any combination thereof. The applicants respectfully request withdrawal of the rejection of claim 20.

### **CONCLUSION**

The applicants respectfully request entry of the foregoing amendments and consideration of the foregoing remarks. It is submitted that claims 1-18 and 20 are now in proper form and scope for allowance. Reconsideration is requested.

No fees are believed due. However, if there are any fees (or refunds) required, the Commissioner is directed to charge (or credit) Deposit Account No. 13-2855 of Marshall, Gerstein & Borun LLP.

In view of the foregoing, the pending application is in condition for allowance. If, in the opinion of the examiner, a telephone conference would expedite prosecution of the subject application, the examiner is invited to call the undersigned agent at the number indicated below.

Respectfully submitted,

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